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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,389	08/22/2000	Kevin K. Funk	10970997-3	8759

7590 11/19/2002

Agilent Technologies
Legal Department 51UPD
Intellectual Property Administration
P O Box 58043
Santa Clara, CA 95052-8043

EXAMINER	
VON BUHR, MARIA N	
ART UNIT	**PAPER NUMBER**
2125	6

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/643,389	Applicant(s) FUNK, KEVIN K.	
	Examiner Maria N. Von Buhr	Art Unit 2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 August 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Examiner acknowledges receipt of Applicant's response to the previous Office action, received August 5, 2002. Claims 13-18 remain pending in this application.

2. The declaration filed on August 5, 2002 under 37 CFR §1.131 has been considered but is ineffective to overcome the Kimura reference (Japanese Application No. 08-177051) and Zvonar et al. references (U.S. Patent Nos. 5,942,739 and 5,828,989).

3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Zvonar et al. references (U.S. Patent Nos. 5,942,739 and 5,828,989) and the Kimura reference (Japanese Application No. 08-177051). While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Applicant's statement of conception, and exhibits in support thereof, are insufficient, because they amount to a mere conclusory statement without more, and the exhibits are not sufficiently explained. See the following excerpts from M.P.E.P. §715.

The essential thing to be shown under 37 CFR §1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR §1.131.

The affidavit or declaration and exhibits must clearly explain which facts or data Applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a

reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by Applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

4. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Zvonar et al. references (U.S. Patent Nos. 5,942,739 and 5,828,989) and the Kimura reference (Japanese Application No. 08-177051) to either a constructive reduction to practice or an actual reduction to practice. Applicant's statement of diligence amounts to a mere conclusory statement, which is unsupported by any evidence. See the following excerpts from M.P.E.P. §715.

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (M.P.E.P. §715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the Applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR §1.131).

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that Applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, Applicant must show evidence of facts establishing diligence.

5. The evidence submitted is insufficient to establish Applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Zvonar et al. references (U.S. Patent Nos. 5,942,739 and 5,828,989) and the Kimura reference (Japanese Application

No. 08-177051). Applicant's statement of reduction to practice amounts to a mere conclusory statement, which is unsupported by any evidence. See the following excerpt from M.P.E.P. §715.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." In re Asahi /America Inc., 94-1249 (Fed. Cir. 1995) (Citing Newkirk v. Lulegian, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

6. Hence, claim 13 stands rejected under 35 U.S.C. §102(a) and (e), as being clearly anticipated by the Kimura reference (Japanese Application No. 08-177051) and both of the Zvonar et al. references (U.S. Patent Nos. 5,942,739 and 5,828,989), respectively, and claims 14-18 stand rejected under 35 U.S.C. §103(a), as obvious over the Kimura reference (Japanese Application No. 08-177051) and both of the Zvonar et al. references (U.S. Patent Nos. 5,942,739 and 5,828,989), as presented in the previous Office action.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR §1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. **Any response to this FINAL Office action should be mailed to:**

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to the Office at:
(703) 746-7238 - for formal communications intended for entry, mark "FORMAL";
(703) 746-7240 - for informal/draft communications; label "PROPOSED" or "DRAFT".

Hand-delivered papers should be brought to Crystal Park II, 2121 Crystal Dr., Arlington, VA, 4th Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maria N. Von Buhr whose telephone number is (703) 305-3837. The Examiner can normally be reached on Monday-Thursday between 8:00 A.M. and 4:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Leo Picard can be reached at (703) 308-0538.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

MNVB
11/15/02

MARIA N. VON BUHR
PRIMARY PATENT EXAMINER
ART UNIT 2125